

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Appln. No.: 10/715,834
Attorney Docket No.: Q78471

REMARKS

Claims 1-12 are all the claims pending in the application. By this Amendment, Applicant amends claims 1, 5, and 9 to further clarify the invention and claims 9-12 for improved conformity with the U.S. practice.

I. Preliminary Matters

Applicant thanks the Examiner for acknowledging Applicant's claim to foreign priority and for indicating receipt of the certified copy of the priority document. Applicant further thanks the Examiner for returning the initialed form PTO/SB/08 submitted with the Information Disclosure Statement filed on November 19, 2003. Applicant also thanks the Examiner for indicating acceptance of the drawing figures filed on June 28, 2004.

II. Summary of the Office Action

Claims 9-12 are rejected under 35 U.S.C. § 101, claims 1, 5, and 9 are rejected under 35 U.S.C. § 102, and claims 3, 4, 7, 8, 11, and 12 are rejected under 35 U.S.C. § 103. Claims 2 and 6 contain allowable subject matter.

The Examiner did not address claim 10 on its merits in the prior art rejections. Accordingly, Applicant assumes that claim 10 contains allowable subject matter.

III. Claim Rejections under 35 U.S.C. § 101

Claims 9-12 are rejected under 35 U.S.C. § 101 as being allegedly directed to non-statutory subject matter. Applicant respectfully requests the Examiner to withdraw this rejection in view of the self-explanatory claim amendments being made herein.

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IV. Claim Rejection under 35 U.S.C. § 102

Claims 1, 5, and 9 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Publication No. 2005/0212670 to Cariffe (hereinafter “Cariffe”). Applicant respectfully traverses these grounds of rejection in view of the following comments.

To be an “anticipation” rejection under 35 U.S.C. § 102, the reference must teach every element and recitation of the Applicant’s claims. Rejections under 35 U.S.C. § 102 are proper only when the claimed subject matter is identically disclosed or described in the prior art. Thus, the reference must clearly and unequivocally disclose every element and recitation of the claimed invention. MPEP § 2131.

In an exemplary, non-limiting embodiment of the present invention, a wireless communication print server enables a printer connected with the wireless communication print server to be made unavailable if parameters of the wireless communication print server remain in the initial state. That is, unauthorized print is prevented since it is impossible to perform the unauthorized print by matching the parameters of a terminal with the parameters of the wireless communication print server in the initial state. In addition, even if the parameters of the wireless communication print server remain in the initial state and accidentally corresponds to those of the terminal, the wireless communication print server can reject the print from the terminal. It will be appreciated that the foregoing remarks relate to the invention in a general sense, the remarks are not necessarily limitative of any claims and are intended only to help the Examiner better understand the distinguishing aspects of the claims mentioned further below.

Independent claim 1, 5, and 9, *inter alia* and in some variation recite: ignoring said print request *corresponding to said parameter in the initial state* if the setting of said parameter is in

the initial state. The Examiner alleges that Cariffe discloses ignoring a print request corresponding to the parameter in the initial state (*see* page 3 of the Office Action). Applicant respectfully disagrees. Applicant has carefully studied the disclosure of Cariffe, which does not disclose or suggest ignoring a print request corresponding to the parameter in the initial state when the setting of the parameters is in the initial state.

Cariffe discloses a technique which automatically changes the setting parameter from the initial state for enabling the operation of devices (§¶ 23 to 41). Cariffe, however, does not disclose ignoring a print request corresponding to the parameter in the initial state if the setting of the parameter is in the initial state. In other words, Cariffe does not disclose or even remotely suggest ignoring “the print request in the initial state” even if “the print request” happens to correspond to the parameter in the initial state. In Cariffe, only adjusting of the printing device to a mode of operation that is useful for interaction with the source device is disclosed (§¶ 36 and 37). Cariffe does not disclose or even remotely suggest a circumstance in which the initial setting of the print server correspond to the source device. Furthermore, Cariffe does not disclose or even remotely suggest ignoring a print request when the setting correspond when the print server remains in the initial state. In short, Cariffe does not disclose ignoring a print request corresponding to the parameter in the initial state when the setting of the parameter is in the initial state.

Therefore, ignoring said print request *corresponding to said parameter in the initial state* if the setting of said parameter is in the initial state, as set forth in claims 1, 5, and 9 is not disclosed by Cariffe. For at least these exemplary reasons, claims 1, 5, and 9 are patentably

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distinguishable from Cariffe. Accordingly, Applicant respectfully requests the Examiner to withdraw this rejection of claims 1, 5, and 9.

V. Claim Rejections under 35 U.S.C. § 103

Claims 3, 4, 7, 8, 11, and 12 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Cariffe in view of U.S. Patent No. 6,314,476 to Ohara (hereinafter “Ohara”).

Claims 3, 4, 7, 8, 11, and 12 depend on claim 1, 5, or 9. Applicant has already demonstrated that Cariffe does not meet all the requirements of independent claims 1, 5, and 9. Ohara is relied upon only for its alleged disclosure of interpreting protocols of print requests and notifying of the status of a printing device (*see* pages 4 and 5 of the Office Action) and as such fails to cure the deficient disclosure of Cariffe. Together, the combined teachings of these references would not have (and could not have) led the artisan of ordinary skill to have achieved the subject matter of claims 1, 5, and 9. Since claims 3, 4, 7, 8, 11, and 12 depend on claim 1, 5, or 9, they are patentable at least by virtue of their dependency.

VI. Allowable Subject Matter

Applicant thanks the Examiner for indicating that claims 2, 6, and 10 contain allowable subject matter. Applicant respectfully holds the rewriting of these claims in abeyance until arguments presented with respect to claims, 1, 5, and 9 have been reconsidered. Applicant does not acquiesce to the Examiner’s reasons for allowance.

VII. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the

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Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly invited to contact the undersigned attorney at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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